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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,203	03/29/2004	Thomas Joseph Pecorini	71566-02	1392

40850 7590 08/24/2005

ERIC D. MIDDLEMAS
EASTMAN CHEMICAL COMPANY
P. O. BOX 511
KINGSPORT, TN 37662-5075

EXAMINER

MCDOWELL, SUZANNE E

ART UNIT PAPER NUMBER

1732

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
After the Filing of an Appeal Brief

Application No.

10/812,203

Examiner

Suzanne E. McDowell

Applicant(s)

PECORINI ET AL.

Art Unit

1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The reply filed 08 August 2005 is acknowledged.

1. ☐ The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:
- a. ☐ The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).
- b. ☐ The affidavit or other evidence is not timely filed before the filing of an appeal brief. See 37 CFR 41.33(d)(2).

2. ☐ The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. ☐ The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. ☒ Other: The remarks filed 8/8/05 are entered, but are not found to be persuasive. Claims 8-12 remain rejected as product-by-process claims. Referring to MPEP 2113, "The patentability of a product does not depend upon its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process"; "Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product."; and "...the dispositive issue is whether the claimed factor [i.e. product] exhibits any unexpected properties compared with the factor disclosed by the prior art."

In the instant case, applicant has not pointed out any way that the product as claimed differs from the prior art product, such as unexpected properties. Applicant argues that the copolyester is different, but not that the product is different. For a product-by-process claim to be patentable, the product must differ from the prior art product. Arguments directed to such differences between products will be considered by the examiner, should they be submitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne E. McDowell whose telephone number is (571) 272-1205. The examiner can normally be reached on M, W, Th 6:30-4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaanni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SUZANNE E. MCDOWELL
PRIMARY EXAMINER